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Filing date: **04/25/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Vineyard Vines, LLC		
Entity	limited liability company	Citizenship	Connecticut
Address	181 Harbor Drive Stamford, CT 06902 UNITED STATES		

Attorney information	Larry C. Jones Alston & Bird LLP 101 S. Tryon Street Suite 4000 Charlotte, NC 28280-4000 UNITED STATES larry.jones@alston.com, wade.perrin@alston.com Phone:704.444.1019
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Registration Subject to Cancellation

Registration No	4943046	Registration date	04/19/2016
Registrant	Stein Mart Holding Corp. 1200 Riverplace Boulevard Jacksonville, FL 32207 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2015/12/15 First Use In Commerce: 2015/12/15 All goods and services in the class are cancelled, namely: Men's clothing, namely, shirts, shorts,pants, and sweaters

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Dilution by blurring	Trademark Act Sections 14(1) and 43(c)
Related Proceedings	Civil Lawsuit---Vineyard Vines, LLC v. Stein Mart, Inc.; Civil Action No. 16cv38 (EDNY)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2318245	Application Date	08/06/1998
Registration Date	02/15/2000	Foreign Priority Date	NONE
Word Mark	VINEYARD VINES		

Design Mark	VINEYARD VINES
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/06/20 First Use In Commerce: 1998/07/03 clothing, namely bathing suits, jackets, pants, scarves, shorts, skirts, shirts, socks, sweaters, sweatshirts, sweatpants, ties, underwear, hats, caps and visors

Attachments	75532085#TMSN.png(bytes) Petition to Cancel VINEYARD PLACE Reg.PDF(3172854 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Larry C. Jones/
Name	Larry C. Jones
Date	04/25/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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VINEYARD VINES, LLC,)	
)	
Petitioner)	
)	Cancellation No. _____
v.)	
)	(Reg. No. 4,943,046;
STEIN MART HOLDING CORP.,)	VINEYARD PLACE)
)	
Registrant)	
-----X		

PETITION TO CANCEL

VINEYARD VINES, LLC, a Connecticut limited liability company having its principal place of business located at 181 Harbor Drive, Stamford, Connecticut 06902 (“Petitioner” or “Vineyard Vines”), believes that it is and will continue to be damaged by the registration of the designation VINEYARD PLACE, namely, Registration No. 4,943,046, which registration issued April 19, 2016 to Stein Mart Holding Corp., a Florida corporation having a mailing address of 1230 Riverplace Boulevard, Jacksonville, Florida 32207 (“Registrant” or “Stein Mart Holding”), and hereby requests that said registration be cancelled.

As grounds for cancellation, Vineyard Vines alleges that:

1. In 1998, brothers Ian and Shep Murray set out to live the American dream and left their corporate jobs on Manhattan’s Wall Street to create a line of whimsical men’s neckties inspired by the colors and designs of Martha’s Vineyard, a destination they loved to visit. The first 800 ties were delivered on July 3, 1998 and were sold out in the first week. As the popularity of the neckties grew, the Vineyard Vines brand was expanded to a full line of casual sportswear for men, women and children, accessories, and products for the home, all drawing inspiration from the relaxed lifestyle of Martha’s Vineyard.

2. For nearly twenty (20) years, and since long prior to either April 21, 2015, the filing date of the intent-to-use application which matured as the challenged registration, or Stein Mart's actual date of first use of the designation VINEYARD PLACE, Vineyard Vines has been engaged in manufacturing, distributing, offering for sale and selling a broad range of uniquely designed luxury brand men's, women's and children's clothing and accessories. As such, Vineyard Vines has become a leader in the clothing and accessories industry in this country and is well known for its colorful nautical designs on its products and in its advertising and promotional materials. From the beginning, Plaintiff has used the designation "VINEYARD VINES" as the brand identifying its clothing and accessory products.

3. The designation VINEYARD VINES has become an iconic trademark and is prominently used on a broad array of men's, women's and children's clothing and accessories, as well as other related goods.

4. Moreover, the VINEYARD VINES mark is consistently depicted on clothing labels and in other materials within a rectangular box and in a particular font with serifs, some examples of which labels are shown below:





5. Vineyard Vines now operates approximately seventy (70) VINEYARD VINES branded standalone retail and outlet locations throughout the United States and continues to expand its retail presence through additional prominent in-store and store-in-a-store facilities in many major retail stores, including Bloomingdale's, Belk, Nordstrom, Saks Fifth Avenue and Island Pursuits, as well as in boutique clothiers throughout the United States. Vineyard Vines also promotes and offers its products for sale on its web site, www.VineyardVines.com.

6. As a consequence of Vineyard Vines' longstanding and continuous use of its VINEYARD VINES mark, Vineyard Vines' business and merchandise have become closely associated with one another in the mind of the public so that the public in this country has come to recognize the business and merchandise of Vineyard Vines by the VINEYARD VINES mark, particularly when that designation is depicted in the font shown above. As such, Vineyard Vines enjoys substantial goodwill and a valuable reputation under the VINEYARD VINES clothing trademark.

7. Because the VINEYARD VINES designation has a distinctive quality and has acquired special and particular significance and very valuable goodwill as an identifier of Vineyard Vines and its merchandise, Vineyard Vines has acquired proprietary rights in the VINEYARD VINES designation under the common law as a trademark and service mark for men's, women's and children's clothing and accessories, and for related goods and services. Those rights extend, without limitation, to the exclusive right to use the VINEYARD VINES

designation nationwide on and in conjunction with such clothing goods and related merchandise and services.

8. Moreover, the VINEYARD VINES designation is the subject of several federal trademark and service mark registrations. Those registrations include, *inter alia*, U.S. Trademark Registration No. 2,318,245 which issued February 15, 2000 from an application filed August 6, 1998, and pertains to the use of the designation VINEYARD VINES in any font as a trademark for various clothing goods. That registration is valid, subsisting and incontestable.

9. Stein Mart, Inc. (“Stein Mart”), an affiliate and licensee of Registrant Stein Mart Holding Corp., operates nearly 300 STEIN MART branded retail stores in about 30 states, which stores sell clothing, accessories and other merchandise. Additionally, Stein Mart operates a website, www.steinmart.com, on which it promotes and sells clothing and other merchandise to the public.

10. It came to Vineyard Vines’ attention recently that Stein Mart is selling clothing under the designation VINEYARD PLACE. That merchandise includes preppy styles of casual and leisure clothing, often in bright colors such as pink, lime green and light blue --- the same styles and colors as used prominently by Vineyard Vines.

11. As reflected in the images below, Stein Mart often presents the VINEYARD PLACE designation on clothing labels, in-store signage, and in other materials within a rectangular box and with the letters of the “VINEYARD” component depicted in a particular font with serifs:



12. The VINEYARD PLACE word mark resembles closely the VINEYARD VINES word mark in that it is comprised of two terms, the first and more prominent component of which is “VINEYARD,” and the second component of which is a word having five letters. Thus, there are unnecessarily imitative similarities of the appearances, sounds and commercial impressions of the VINEYARD PLACE and VINEYARD VINES word marks *per se*.

13. Further, in depicting the VINEYARD PLACE designation on sewn-in neck labels, in-store signage and elsewhere, Stein Mart has unnecessarily imitated the particular look and manner of presentation long used by Vineyard Vines in conjunction with its iconic VINEYARD VINES brand. As reflected below, Stein Mart’s mimicry is exacerbated by the presentation of the VINEYARD PLACE designation within a rectangular box, with the common “VINEYARD” component being significantly larger and more prominent than the “PLACE”

component, and with all of the letters of the “VINEYARD” component in the same font, or a very highly similar font, as that in which the public has become accustomed to seeing the VINEYARD VINES designation.



As such, the VINEYARD PLACE clothing is likely to be perceived by the public as an extension of the well-known VINEYARD VINES line of clothing.

14. Still further, and as reflected in the photographic images below, Stein Mart has displayed the VINEYARD PLACE clothing in its retail stores near or side-by-side authentic VINEYARD VINES clothing, thus enhancing the likelihood that customers will associate the two brands.



Moreover, Stein Mart's display headers and in-store signage directing customers to its VINEYARD PLACE clothing have incorporated prominent nautical images, just as Vineyard Vines has long incorporated nautical images prominently in its advertising and promotional materials.



In fact, the display headers' identification of the merchandise and its display shelves within each Stein Mart store as "VINEYARD PLACE" further connotes falsely that there is some form of commercial association between the VINEYARD VINES and VINEYARD PLACE clothing.

15. Because of such similarities, members of the public are likely to be initially interested in the VINEYARD PLACE clothing goods upon encountering them for sale by Stein Mart. Thus, such mimicry is likely to lead to either initial interest confusion or point-of-sale confusion as to the source, sponsorship or other commercial affiliation of the VINEYARD PLACE clothing goods with Vineyard Vines and its clothing.

16. Additionally, because of such similarities, members of the public, who encounter the VINEYARD PLACE clothing goods in the possession of Stein Mart's customers or other persons, are likely to experience post-sale confusion as to the source, sponsorship or other commercial affiliation of the VINEYARD PLACE clothing goods with Vineyard Vines and its clothing.

17. On April 21, 2015, Stein Mart Holding filed an application to register the designation VINEYARD PLACE. That application matured as Registration No. 4,943,046, which registration issued April 19, 2016 and pertains to the use of the designation VINEYARD PLACE on and in conjunction with the following goods: Men's clothing, namely, shirts, shorts, pants, and sweaters.

18. As noted previously, the VINEYARD PLACE word mark resembles closely the VINEYARD VINES word mark in that it is comprised of two terms, the first and more prominent component of which is "VINEYARD," and the second component of which is a word having five letters. Thus, there are unnecessarily imitative similarities of the appearances, sounds and commercial impressions of the VINEYARD PLACE and VINEYARD VINES word marks *per se*.

19. Further, as also noted previously, in depicting the VINEYARD PLACE designation in its actual use as a clothing trademark on sewn-in neck labels, in-store signage and

elsewhere, Stein Mart has imitated the particular look and manner of presentation long used by Vineyard Vines in conjunction with its iconic VINEYARD VINES brand.

20. Thus, the VINEYARD PLACE designation is quite similar visually, aurally and in connotation and commercial impression to the VINEYARD VINES mark. These characteristics contribute significantly to a likelihood of confusion. Moreover, the goods listed in Stein Mart Holding's VINEYARD PLACE registration are the same as the goods which Vineyard Vines promotes and sells under its VINEYARD VINES mark. This further enhances the likelihood of confusion. Thus, the designation VINEYARD PLACE, when used on or in connection with the goods listed in the registration at issue, is likely to deceive or cause confusion or mistake as to the source, sponsorship, or other commercial affiliation of Stein Mart's VINEYARD PLACE clothing goods in relation to Vineyard Vines and its VINEYARD VINES clothing goods.

21. Still further, the VINEYARD VINES clothing mark is not only a distinctive mark, but also a famous mark, and that designation acquired its status as a famous mark prior to either the first usage in commerce of the VINEYARD PLACE designation or the effective filing date of the application which matured as the challenged registration.

22. Hence, the registration of the VINEYARD PLACE designation should be cancelled on the basis that the usage of that designation on and in conjunction with the goods listed therein: (i) is likely to cause confusion with the VINEYARD VINES mark; and (ii) is likely to cause dilution by blurring of the famous VINEYARD VINES mark.

SUMMARY

23. Registration No. 4,943,046 of the VINEYARD PLACE designation should be cancelled under 15 U.S.C. § 1092.

24. Accordingly, Vineyard Vines asserts, pursuant to 15 U.S.C. § 1092, that it is and will continue to be damaged by the registration of the VINEYARD PLACE designation, namely, Registration No. 4,943,046.

WHEREFORE, Vineyard Vines prays that this petition to cancel be sustained in favor of Vineyard Vines and that said registration of the VINEYARD PLACE designation be cancelled.

Please charge all fees incurred by Vineyard Vines in conjunction with this proceeding to the firm's Deposit Account No. 16-0605.

Date: April 25, 2016

Respectfully submitted,



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Attorneys for Petitioner,
Vineyard Vines, LLC

CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Petition to Cancel" was duly served on Respondent by depositing a copy of same in the United States mail, first-class postage prepaid, on the 25th day of April, 2016, addressed to Respondent's attorney of record as follows:

Katharine F. Rowe
Smith Gambrell & Russell LLP
50 N. Laura St., Suite 2600
Jacksonville, FL 32202-3629



Larry C. Jones